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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,849	03/21/2001	Yusuke Hayashi	826.1704	1438
21171	7590	05/10/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CAMPBELL, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,849

Applicant(s)

HAYASHI, YUSUKE

Examiner

Joshua D Campbell

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: Request for continued examination filed on 04/04/2005.
2. Claims 1-15 are pending in this case. Claims 1, 2, 5, 7, 8, 11, 12, 13, 14, and 15 are independent claims. Claims 1, 2, 5, 7, 8, and 11-15 have been amended.
3. The rejection of claims 5, 6, 8, 10, and 12 under 35 U.S.C. 102(e) as being anticipated by Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182, issued on February 22, 2000) has been withdrawn due to amendments.
4. The rejection of claims 1-4, 7, 9, 11, and 13-15 under 35 U.S.C. 103(a) as being unpatentable over Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182, issued on February 22, 2000) has been withdrawn due to amendments.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 2, 4, 11, and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182, issued on February 22, 2000).

**Regarding independent claim 2**, Nehab discloses a method, apparatus, and computer readable medium in which preferences of a user that corresponds to required information are stored (column 7, lines 23-49 and column 9 lines 4-46 of Nehab).

Nehab discloses a method in which a request is received from an the user terminal, based on a user profile, which is responded to by providing information and the way it is handled in the information source (column 6, lines 30-57 of Nehab). At this point, a user profile designates which information is to be used according to layout information (column 2, lines 25-65 of Nehab). The information is then distributed to the user terminal and the information is displayed (column 9, lines 4-46 of Nehab).

**Regarding dependent claim 4**, Nehab discloses a method, apparatus, and computer readable medium in which the information indicates the position (i.e. section and heading) of the information in the information source (column 1, lines 5-35 and column 2, lines 25-50 of Nehab).

**Regarding independent claim 11**, Nehab discloses a method, apparatus, and computer readable medium in which preferences of a user that corresponds to required information are stored (column 7, lines 23-49 and column 9 lines 4-46 of Nehab).

Nehab discloses a method in which a request is received from an the user terminal, based on a user profile, which is responded to by providing information and the way it is handled in the information source (column 6, lines 30-57 of Nehab). At this point, a user profile designates which information is to be used according to layout information (column 2, lines 25-65 of Nehab). The information is then distributed to the user terminal and the information is displayed (column 9, lines 4-46 of Nehab).

**Regarding independent claim 13,** Nehab discloses a method, apparatus, and computer readable medium in which preferences of a user that corresponds to required information are stored (column 7, lines 23-49 and column 9 lines 4-46 of Nehab).

Nehab discloses a method in which a request is received from an the user terminal, based on a user profile, which is responded to by providing information and the way it is handled in the information source (column 6, lines 30-57 of Nehab). At this point, a user profile designates which information is to be used according to layout information (column 2, lines 25-65 of Nehab). The information is then distributed to the user terminal and the information is displayed (column 9, lines 4-46 of Nehab).

**Regarding independent claim 14,** the claim incorporates substantially similar subject matter as claim 11. Thus, the claim is rejected along the same rationale as claim 11.

**Regarding independent claim 15,** Nehab discloses a method, apparatus, and computer readable medium in which preferences of a user that corresponds to required information are stored (column 7, lines 23-49 and column 9 lines 4-46 of Nehab).

Nehab discloses a method in which a request is received from an the user terminal,

based on a user profile, which is responded to by providing information and the way it is handled in the information source (column 6, lines 30-57 of Nehab). At this point, a user profile designates which information is to be used according to layout information (column 2, lines 25-65 of Nehab). The information is then distributed to the user terminal and the information is displayed (column 9, lines 4-46 of Nehab).

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 3, 5-10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182, issued on February 22, 2000) in view of Ferguson (US Patent Number 5,649,186, issued on July 15, 1997).

**Regarding independent claim 1,** Nehab discloses a method, apparatus, and computer readable medium in which preferences of a user that corresponds to required information are stored (column 7, lines 23-49 and column 9 lines 4-46 of Nehab). Nehab discloses a method in which a request is received from an the user terminal, based on a user profile, which is responded to by providing information and the way it is handled in the information source (column 6, lines 30-57 of Nehab). At this point, a user profile designates which information is to be used according to layout information (column 2, lines 25-65 of Nehab). The information is then distributed to the user terminal and the information is displayed (column 9, lines 4-46 of Nehab). Nehab

discloses that the information that is transmitted includes both the headline and the article information (Figure 3A-3D of Nehab). Nehab does not disclose that the information can be only the headline information. However, Ferguson discloses a method, apparatus, and computer readable medium in which only the headline information is presented to the user, until the user selects the headline, which links to the article that the headline designates (Figure 5 and column 6, lines 1-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Nehab and Ferguson because it would have allowed the amount of data initially transmitted and maintained to be reduced.

**Regarding dependent claim 3**, Nehab discloses a method, apparatus, and computer readable medium in which the information indicates the position (i.e. section and heading) of the information in the information source (column 1, lines 5-35 and column 2, lines 25-50 of Nehab).

**Regarding independent claim 5**, Nehab discloses a method, apparatus, and computer readable medium in which preferences of a user that corresponds to required information are stored (column 7, lines 23-49 and column 9 lines 4-46 of Nehab). Nehab discloses a method in which a request is received from an the user terminal, based on a user profile, which is responded to by providing information and the way it is handled in the information source (column 6, lines 30-57 of Nehab). At this point, a user profile designates which information is to be used according to layout information (column 2, lines 25-65 of Nehab). The information is then distributed to the user terminal and the information is displayed (column 9, lines 4-46 of Nehab). Nehab

discloses that the information that is transmitted includes both the headline and the article information (Figure 3A-3D of Nehab). Nehab does not disclose that the information can be only the headline information. However, Ferguson discloses a method, apparatus, and computer readable medium in which only the headline information is presented to the user, until the user selects the headline, which links to the article that the headline designates (Figure 5 and column 6, lines 1-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Nehab and Ferguson because it would have allowed the amount of data initially transmitted and maintained to be reduced.

**Regarding dependent claim 6**, Nehab discloses a method, apparatus, and computer readable medium in which the information indicates the position (i.e. section and heading) of the information in the information source (column 1, lines 5-35 and column 2, lines 25-50 of Nehab).

**Regarding independent claim 7 and dependent claim 9**, the claims incorporate substantially similar subject matter as claims 1 and 3. Thus, the claims are rejected along the same rationale as claims 1 and 3.

**Regarding independent claim 8 and dependent claim 10**, the claims incorporate substantially similar subject matter as claims 5 and 6. Thus, the claims are rejected along the same rationale as claims 5 and 6.

**Regarding independent claim 12**, Nehab discloses a method, apparatus, and computer readable medium in which preferences of a user that corresponds to required information are stored (column 7, lines 23-49 and column 9 lines 4-46 of Nehab).



Nehab discloses a method in which a request is received from an the user terminal, based on a user profile, which is responded to by providing information and the way it is handled in the information source (column 6, lines 30-57 of Nehab). At this point, a user profile designates which information is to be used according to layout information (column 2, lines 25-65 of Nehab). The information is then distributed to the user terminal and the information is displayed (column 9, lines 4-46 of Nehab). Nehab discloses that the information that is transmitted includes both the headline and the article information (Figure 3A-3D of Nehab). Nehab does not disclose that the information can be only the headline information. However, Ferguson discloses a method, apparatus, and computer readable medium in which only the headline information is presented to the user, until the user selects the headline, which links to the article that the headline designates (Figure 5 and column 6, lines 1-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Nehab and Ferguson because it would have allowed the amount of data initially transmitted and maintained to be reduced.

### ***Response to Arguments***

9. Applicant's arguments filed 04/04/2005 have been fully considered but they are not persuasive.

Regarding the applicant's arguments on pages 8-9, regarding independent claims 5, 8, and 12, and the limitation, "...externally receiving information as headlines attached to respective information sets that may correspond to the received request and

a way the information sets are handled in an information source as layout information...” the examiner maintains that the limitation is taught by Nehab. In Nehab, the information retrieval system, which runs on a user terminal, makes requests to a server external to the system itself (column 7, lines 23-49 and column 9 lines 4-46 of Nehab). The server responds by transmitting the information back to the system (column 6, lines 30-57 of Nehab). The information includes headlines and also includes the way in which the articles were handled in the previous information source, which is used in the parsing and ordering step of Nehab (column 6, lines 30-57 of Nehab).

Regarding the applicant's arguments on pages 9 and 10, regarding independent claims 1, 7, and 8, and the limitation involving the user making the request instead of the system. The claims as amended now state that the request is made by a user terminal, as opposed to a “user” as it was previously. Nehab discloses that a system exists on a user terminal that makes the requests for information (Figure 1 and column 9 lines 4-46 of Nehab). Thus, the limitation, as currently presented, is taught by Nehab, and the arguments regarding the previous state of the claim are moot.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

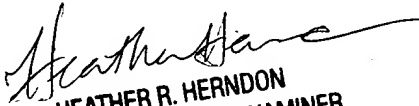
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
May 3, 2005

  
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